REMARKS

Claims 1-3, 7-8, 10-11, 13-15, 21-27, 30-32, 34-35, 37-49-57, 63, 65, 67-68, 70-72, 75, 77-78, 80-89, and 91 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,205,481 (_Heddaya_) in view of U.S. Patent No. 6,742,033 (_Smith_) and US 2002/0147887 (_Copeland_) as well as being unpatentable over _Heddaya_ in view of _Smith_ and U.S. Patent No. 6,253,208 (_Wittgreffe_).

Claims 4-5, 33, and 73 stand rejected under 35 U.S.C. § 103(a) as being uppatentable over _Heddaya_, _Smith_, and _Copeland_ and further in view of U.S. Patent No. 6,182,085 (Eichstaedt) as well as being unpatentable over _Heddaya_, _Smith_, and _Wittgreffe_ and further in view of _Eichstaedt_.

Claims 6, 9, 19, 28, 36, 58-62, 64, 74, 76, and 90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over _Heddaya_, _Smith_, and _Copeland_, and further in view of U.S. Patent No. 6,092,192 (_Reiche_) as well as being unpatentable over _Heddaya_, _Smith_, and _Wittgreffe_, and further in view of _Reiche_.

Claim 12 and 66 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over _Heddaya_, _Smith_, and _Copeland_ further in view of U.S. Patent No. 6,549,935 (_Lapstun_) as well as being unpatentable over _Heddaya_, _Smith_, and _Wittgreffe_ and further in view of _Lapstun_.

Claims 16-17, 20, 69, and 79 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over _Heddaya_, _Smith_, and _Copeland_ further in view of U.S. Patent No. 5,797,128 (_Birnbaum_) as well as being unpatentable over _Heddaya_, _Smith_, and _Wittgreffe_ further in view of _Birnbaum_.

Claim 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over _Heddaya_, _Smith_, _Copeland_, and _Birnbaum_ further in view of U.S. Patent No. 6,549,935 (_Lapstun_).

Claim 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Heddaya*, *Smith*, *Copeland*, and *Birnbaum* further in view of *Reiche* as well as being unpatentable over *Heddaya*, *Smith*, *Wittegreffe*, and *Birnbaum* further in view of *Reiche*.

Claim 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Heddaya*, *Smith*, and *Wittgreffe* further in view of U.S. Patent App. No. U.S. 2002/0078165 (*Genty*).

I.   *Copeland* was filed after the date of invention and thus cannot be used to anticipate or render obvious the claimed subject matter.

Copeland was filed on December 18, 2000, and was published on October 10, 2002. Therefore, this reference is being cited as 102(e) art and is thus eligible to be overcome based upon an affidavit or declaration from an inventor pursuant to 37 C.F.R. § 1.131. See MPEP § 715. Applicants filed an affidavit / declaration pursuant to 37 C.F.R. § 1.131 in response to the previous Office Action.

I-A.   *Exhibit A* submitted by the Applicants' pursuant to a 37 C.F.R. § 1.131 declaration presents a clear showing of actual reduction to practice prior to the effective date.

The Office Action states that Applicants merely made a vague and general statement in the § 1.131 Declaration that the claimed invention was reduced to practice and tested to verify that it worked for its intended purpose prior to December 18, 2000.

Applicants respectfully submit that the *Exhibit A*, titled *"Oracle CRM 11i "Hornet" Release: JTF Page Prefabrication,"* in said affidavit / declaration presents a clear showing that the claimed invention actually existed and worked for its intended purpose prior to December 18, 2000 and thus suffice to show actual reduction to practice prior to said date.

Applicants first respectfully note that page one of the *Exhibit A* demonstrates that one of the problems that "JTF Prefab" was able to solve is to improve page retrieval time through prefabrication of these pages, especially those with dynamic content based upon the user where caching is unable to achieve the same.

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Moreover, the <u>last page</u> of *Exhibit A* titled *"Response Time For Home Page"* demonstrated one example that the response time for a given home page was improved from 3.76 seconds, done without prefabrication, to 0.53 seconds with prefabrication. *Exhibits B* also presents various graphs demonstrating the variations of the PRF (Page Request Feeder) Q time and process time as well as the Refresh Time corresponding to different thread counts. All these graphs and statements in *Exhibit A* clearly demonstrate that not only did the claimed invention exist prior to December 18, 2000, but it was tested, also prior to December 18, 2000, in various ways to verify that the claimed invention worked for its intended purpose of improving page retrieval time by using the claimed invention as required by MPEP 715.07. Furthermore, Applicants' recognition of one of the goals of the claimed invention, i.e., to improve page retrieval time by using page prefabrication, together with the improvement in response time from 3.76 seconds to 0.53 seconds actually demonstrated that Applicants appreciated and recognized the claimed invention prior to December 18, 2000 as required by MPEP 2138.05.

As such, Applicants respectfully submit that *Exhibit A* of the Applicants declaration submitted in response to the previous Office Action suffices to show actual reduction to practice prior to December 18, 2000, and thus <u>Copeland</u> cannot be used to anticipate or render obvious the claimed subject matter.

I-B. Applicants explicitly made a statement in the 37 C.F.R. § 1.131 Declaration that the claimed invention was conceived and reduced to practice prior to December 18, 2000.

The Office Action states that Applicants neither established that the invention predates December 18, 2000 nor made a statement relating to the limitations of the dependent claims. Applicants respectfully disagree.

Applicants first respectfully note that "[w]hen alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her

actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date." MPEP 715.07.

In Item 3 of the Declaration filed together with the previous response, the Inventors explicitly declared that "we believe that we had a definite and complete idea of, and had actually reduced to practice, the designs embodying all of the elements of claims 1-91 prior to December 18, 2000." Thus, Applicants respectfully submit that Applicants explicitly made a statement in the Declaration that the claimed invention was conceived and reduced to practice prior to December 18, 2000 in accordance with the requirement under MPEP 715.07.

I-C. ***Exhibit B*, titled "*Design Specification for JTF Page Fabrication, CRM Application, 11i*," discloses all the claimed limitations of claim 1.**

The Office Action further states that *Exhibit B* fails to disclose both "wherein the prefabrication is not in response to a request for the first page by a user," and "querying a database."

Applicants respectfully submit that *Exhibit B* in fact discloses said claimed limitations for at least the reasons as stated below.

I-C-1. ***Exhibit B* discloses the claimed limitation of "wherein the prefabrication is not in response to a request . . . by a user."**

Section 2 on **p. 4** of *Exhibit B* describes the high level design of the present invention and discloses "[t]he key idea behind page prefabrication is to create and store the HTTP Response for a URL request *a priori, so that when an user actually requests the URL it can be serviced immediately.*" That is, without going into the technical details, such prefabricated pages are actually prefabricated a priori - before the user actually requests the URL.

Next, Applicants respectfully submit that *Exhibit B* discloses the aforementioned claimed limitation because each of the prefabricator's components as disclosed in *Exhibit B* may serve its intended functions without referencing to any user requests.

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P. 5 of *Exhibit B* shows the three major components of the design to be the prefabricator, interceptor, and the cache where **at least one of the embodiments of** the claimed invention as well as *Exhibit B* are focusing upon the interceptor and the prefabricator. Applicants respectfully note that *Exhibit B* demonstrates that both the interceptor and the prefabricator may serve their respective functions without receiving any user requests.

I-C-1-(a). <u>**The Interceptor**</u>

Fig. 1 on **p. 4** and **Section 3.9** of *Exhibit B* on **pp. 20-21** show that the interceptor intercepts the URL requests either from the prefabricator or the user and thereby determines whether the request can be serviced from the cache or not. **Section 3.9** further discloses the basic algorithm implemented by the interceptor to include both "[i]f from user" and "[i]f from spider" and "[i]n either case, response should also be T-d to the URL Collector . . . ." As such, the interceptor can clearly serve its intended function without referencing to any user requests, and *Exhibit B* thus discloses the aforementioned limitations.

I-C-1-(b). <u>**The Prefabricator**</u>

Applicants further submit that the prefabricator may also serve its intended functions without any user requests. Section 3 of *Exhibit B* shows that the prefabricator includes, to the extent pertinent to page prefabrication, a start loader, a benefit analyzer, a URL collector, and a page generator.

Pertinent to one embodiment of the present Application, **Fig. 3** on **p. 3** and **Section 3.3** on **p.12** of *Exhibit B* shows that the Benefit Analyzer receives PRBs to be processed from both the URL Collector and the Start Loader and determines the next set of pages to prefabricate. **Section 3.3** on **p.12** further discloses the selection algorithm of how the Benefit Analyzer determines which set of pages to prefabricate and what information must be made available to the Benefit Analyzer in order for the Benefit Analyzer to serve its intended functions. As **Section 3.3** clearly demonstrates, the selection algorithm of the Benefit Analyzer is based primarily upon the current fabrication rate of the system but need not rely on any user requests to make such determination.

Moreover, pertinent to one embodiment of the present Application as claimed in claim 1, **Section 3.2** describes the Start Loader. Moreover, the logic for the Start Loader to implement the Runnable interface further describes how the Start Loader serves its intended functions. More specifically, the Start Loader uses the PRBEvaluateInterface implementer to generate all the PRBs that make up the initial workload; it then invokes the Benefit Analyzer to populate the PRBs; and the thread periodically wakes up to check if new PRBs need to be created and creates them. From this description, it is clear that the Start Loader requires no user requests to serve its intended purposes.

Similarly, **Section 3.4** describes the algorithm for the Page Request Feeder which performs page generation from the PRBs that have been processed by the Benefit Analyzer. As it can be seen from the description, the algorithm may but requires no user request to serve its intended function.

Furthermore, also pertinent to one embodiment of the present Application as claimed in claim 1, **Sections 3.5** and **3.6** together with **Figs. 1-3** describe the functions of the URL Collector and the Page Generator. These paragraphs are absolutely silent on taking on any user requests in order to serve the functions. More specifically, Section 3.5 describes that the URL Collector functions like a web-crawler. It is well know in the art that a web-crawler typically functions in an automated manner. The Page Generator may also function free of any user requests because the Page Generator is interposed between the Page Request Feeder and the URL Collector, both of which may function independently from any user requests.

I-C-2. *Exhibit B* **discloses the claimed limitation of "querying a database . . . ."**

Pertinent to one embodiment of the present invention as claimed in claim 1, Section 3.2 explicitly discloses that the functions of the default implementer of the PRBEvaluateInterface including "query the find_user, find_user_resp_groups and find_responsibility tables . . . ." Thus, *Exhibit B* clearly discloses the claimed limitation of "querying a database . . ." of claim 1.

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As such, Applicants respectfully submit that *Exhibit B* discloses the aforementioned claimed limitations and thus meets the requirements for facts and documentary evidence as required by 37 CFR § 1.131 and MPEP 715.07.

II.   The cited passages of *Copeland* do not disclose the claimed limitations that both Heddaya and Smith fail to disclose.

The Office Action acknowledges that Heddaya and Smith fail to disclose the claimed limitation of *"querying a database to obtain cached data . . . processing the data . . . and packing the information associated with the data"* but cites to **para. 0038-0041** of *Copeland* and concludes that the cited paragraphs disclose the aforementioned claimed limitations Applicants agree that Heddaya and Smith do not disclose the above limitations, but Applicants respectfully disagree that Copeland discloses them.

The cited passages of Copeland disclose a method of improving the Internet traffic by decreasing the frequency of database accesses and by avoiding redundant execution of commands and JSPs. **Para. 0039-0040.**

However, this is not the claimed limitations of claim 1. The pertinent portion of claim 1 recites the limitation of prefabricating a page, and the prefabricating step comprises querying a database, processing the data obtained, *and* packaging the information associated with the data so obtained. Nonetheless, Copeland teaches the opposite. ¶ 0041 of Copeland discloses that "[i]n many cases, it would be advantageous to cache a reusable command . . . . As an *alternative to caching the command* itself, we may cache the fully rendered HTML . . . ." (Emphasis added). Moreover, ¶ 0041 states that "if we *cache the HTML*, the underlying data does *not have to [be] rendered into HTML code* . . . if we cache the command . . . we *avoid having to access the database* . . . ." (Emphasis added). That is, the cited passages of Copeland in fact disclose a method of either *caching the HTML without rendering (or processing)* the underlying data *or caching the command while avoiding accessing the database*. ¶ 0041. This is contrary to the

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claimed limitations of "querying a database to obtain cached data," "processing the data" AND "packaging the information associated with the data" of claim 1.

Claims 49, 58, and 63 disclose similar limitations as does claim 1. Claims 23, 70-71, and 73-74 constitute the system and computer program product claims implementing the above method claims and thus are believed to be also allowable over Heddaya, Smith, and Copelandfor at least the foregoing reasons. As such, Applicants respectfully submit that claims 1, 23, 49, 58, 70-71, 73-74, and their respective dependent claims are believed to be allowable over Heddaya, Smith, and Copeland.

III. ___Wittgreffe___ **does not disclose, teach, or suggest the claimed limitations of claim 1 that both** ___Heddaya___ **and** ___Smith___ **fail to disclose.**

The Office Action further acknowledges that ___Heddaya___ and ___Smith___ fail to disclose the claimed limitations of "wherein the act of fabricating the first pages comprises querying a database to obtain cached data, processing the data received . . ., and packaging information associated with the data . . ." of claim 1. Nonetheless, the Office Action cites to **col. 2, ll. 25-50** of ___Wittgreffe___ and concludes that the cited passages of ___Wittgreffe___ disclose the aforementioned claimed limitation. Applicants agree that Heddaya and Smith fail to disclose such claimed limitations, but Applicants respectfully disagree that ___Wittgreffe___ cures such deficiencies of ___Heddaya___ and ___Smith___. Applicants note that in order to establish obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the cited references. MPEP 2143.03.

___Wittgreffe___ addresses the problem of, in the context of property sale, an individual user's need to "visit almost all the known advertisers to gather a reasonable sample of suitable property" due to the fact that each individual agent "is likely to advertise only a relatively small number of properties at any one time." **Col. 2, ll. 6-20.** ___Wittgreffe___ thereby discloses an information access system that establishes a network connection to individual Internet sites, transmits a formatted query to said Internet sites to obtain results in response to the query, and

stores said results in a database or update an existing database. **Col. 2, ll. 6-20** and **col. 4, l. 64 - col. 6, l. 10.** In other words, Wittgreffe's system merely creates a database that contains relevant information of interest to individual users from various Internet sites which provide similar information to solve the problem of the individual user's need to visit and query each individual sites (advertiser) in exchange for a relative small piece of information from each individual sites.

This is not, however, the claimed limitation. The pertinent portion of claim 1 discloses the limitation of prefabricating a page. However, claim 1 does not merely disclose querying a database. Rather, the act of prefabricating pages in claim 1 comprises querying a database *to obtain cached data*. In contrast, Wittgreffe's system merely transmits a query to an Internet site to obtain *information*. Nothing is *Wittgreffe* suggests that the information sought to be obtained by the system is cached by any means. Rather, *Wittgreffe* merely retrieves data from the Internet site in accordance with the queries transmitted to said Internet site.

As such, Applicants respectfully submit that Wittgreffe does not even remotely disclose, teach, or suggest the aforementioned limitation and thus fails to cure the deficiency of *Heddaya* and *Smith*. Therefore, claim 1 is again believed to be allowable over *Heddaya*, *Smith*, and *Wittgreffe*.

Claims 49, 58, and 63 disclose similar limitations as does claim 1. Claims 23, 70-71, and 73-74 represent the system and computer program product claims implementing the above method claims and thus are believed to be allowable over Heddaya, Smith, and Wittgreffe for at least the foregoing reasons. As such, Applicants respectfully submit that claims 1, 23, 49, 58, 70-71, 73-74, and their respective dependent claims are believed to be allowable over Heddaya, Smith, and Wittgreffe.

CONCLUSION

Based on the foregoing, all remaining claims are in condition for allowance, which is respectfully requested. If the Examiner has any questions or comments regarding this response, the Examiner is respectfully requested to contact the undersigned at the number listed below.

The Commissioner is authorized to charge any fees due in connection with the filing of this document to Bingham McCutchen's Deposit Account No. **50-2518,** referencing billing number **7011452001**. The Commissioner is authorized to credit any overpayment or to charge any underpayment to Bingham McCutchen's Deposit Account No. **50-2518,** referencing billing number **7011452001**.

Respectfully submitted,

Bingham McCutchen LLP

Dated: <u>November 27, 2006</u>   By: _____
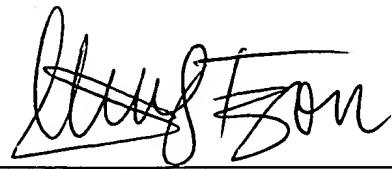
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